

REMARKS:

Claims 1-48 are currently pending in the application. Claims 5-7, 15, 21-23, 31, 36, and 46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 2, 4, 8-18, 20, 24-33, 35, and 39-47 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,600,789 to Parker et al. ("Parker") in view of U.S. Patent No. 5,909,544 to Anderson, II et al. ("Anderson"). Claims 3, 5-7, 19, 21-23, 34, 36-38, and 48 stand rejected under 35 U.S.C. § 103(a) over Parker in view of Anderson and in further view of U.S. Patent No. 6,766,481 B2 to Estep et al. ("Estep").

Although the Applicant believes claims 15, 31, 46, and 48 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicant has cancelled independent claim 48 without prejudice and amended claims 15, 31, and 46 to more particularly point out and distinctly claim the Applicant's invention. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 112:

Claims 5-7, 15, 21-23, 31, 36, and 46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, the Examiner states that the "terms 'substantially' and 'essentially' are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention." (19 May 2005 Office Action, Page 2). In response, the Applicant has amended dependent claims 15, 31, and 46 to remove the phrase "essentially" and to more particularly point out and distinctly claim the subject matter which Applicant regards as the invention. However, the Applicant respectfully disagrees with the Examiner and does not understand why the phrase "substantially" is thought to be

confusing. The Applicant conducted a search on the United States Patent and Trademark web site for patents in which the phrase “substantially” is used in claims. The search revealed that 807,310 patents have issued in the United States between 1976 and the present. The Applicant respectfully requests that the Examiner cite a specific rule in 37 C.F.R. or in the MPEP that restricts the use of the word “substantially” in the claims. The Examiner may call the undersigned at (817) 447-9955 if the Examiner believes that it would be easier to discuss the source of confusion over the phone. Thus, the allegation in the present Office Action that the phrase “substantially” is indefinite is respectfully traversed.

For example, with respect to dependent claim 5, this claim recites:

the test server engine is further operable to generate a test results web page comprising test results for a plurality of software GUI test instances, including the test result for the most recently executed software GUI test instance, substantially immediately upon receiving the test result from the particular distributed test execution computer on which the most recently executed software GUI test instance was executed; and

the system further comprises a web server operable to communicate the test results web page for display on a user system to provide substantially real-time test results reporting. (Emphasis Added).

Dependent claims 21 and 36 recite similar limitations.

The Applicant directs the Examiners attention to the specification, which Applicant is his own lexicographer and defines the phrase “substantially”. The Applicant respectfully directs the Examiners attention to at least Page 11, Lines 21-31, which recites:

Test server engine 24 receives test results for executed test instances from client controllers 36 of client systems 32 and stores the test results in test results database 30. In one embodiment, code of test server engine 24 triggers a Perl or other script upon receipt of a test result, which stores the test result in test results database 30 and triggers a Perl or other script to generate a test results web page (possibly updating an existing test results web page) to reflect the newly received test result along with previous test results. As a result, certain embodiments may provide substantially real-time reporting of software GUI test results. The test results web page may be periodically “pushed” to one or more client computers 38 associated with one or more users, made accessible to

users on an as needed “pull” basis, or may be provided to users in any other suitable manner. (Emphasis Added).

In view of the specification at page 11 lines 21-31, the Applicant defines the phrase “substantially” as having a quantity of time between when the test server engine receives the test results until triggers are initiated to generate a test results web page and as a result may provide a substantially real-time reporting of the test results. In essence, the phrase “substantially” means that the test results are generated almost immediately upon receiving the test result and the real-time reporting occurs to a large extent at real-time. Where an explicit definition is provided by the Applicant for a term, that definition will control interpretation of the term as it is used in the claim. MPEP § 2111.02. Thus, the Applicant respectfully submits that the meaning of the phrase “substantially” in claims 5-7, 21-23, and 36-38 is definite and disclosed in the specification with the requisite degree to provide one of ordinary skill in the art at the time of the invention to be reasonably apprised of the scope of the invention.

For at least these reasons, the Applicant respectfully submits that the phrase “substantially” is definite and defined in the specification. The Applicant further submits that amended dependent claims 15, 31, and 46 are considered to be in full compliance with the requirements of 35 U.S.C. § 112 and are considered to be in condition for allowance. The Applicant still further submits that dependent claims 5-7, 21-23, and 36-38 are in full compliance with the requirements of 35 U.S.C. § 112 and are considered to be in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 5-7, 15, 21-23, 31, 36, and 46 under 35 U.S.C. § 112 be reconsidered and that claims 5-7, 15, 21-23, 31, 36, and 46 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 2, 4, 8-18, 20, 24-33, 35, and 39-47 stand rejected under 35 U.S.C. § 103(a) over Parker in view of Anderson. Claims 3, 5-7, 19, 21-23, 34, 36-38, and 48 stand rejected under 35 U.S.C. § 103(a) over Parker in view of Anderson and in further view of Estep.

In an effort to expedite prosecution of this Application, the Applicant has cancelled independent claim 48 without prejudice and amended dependent claims 15, 31, and 46 to more particularly point out and distinctly claim the Applicant's invention. In so canceling independent claim 48 the Applicant has rendered moot the Examiners rejection of independent claims 48 under 35 U.S.C. § 103(a). In so doing, the Applicant makes no admission concerning the merits of the Examiner's now-moot rejection and denies affirmatively any statement of averment of the Examiner that is not specifically addressed in this Amendment.

The Applicant respectfully submits that Parker or Anderson either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1, 2, 4, 8-18, 20, 24-33, 35, and 39-47. The Applicant further submits that Parker, Anderson, or Estep either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 3, 5-7, 19, 21-23, 34, and 36-38. Thus, the Applicant respectfully traverses the Examiners obvious rejection of claims 1-47 under 35 U.S.C. § 103(a) over the proposed combination of Parker, Anderson, or Estep either individually or in combination.

For example, with respect to independent claim 1, this claim recites:

A system for distributed automated software graphical user interface (GUI) testing, comprising:

a centralized test queue operable to store a plurality of software GUI test instances to be executed by a plurality of distributed test execution computers, each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed; and

a test server engine operable to, for each distributed test execution computer:

receive a request for a software GUI test instance from a particular distributed test execution computer in response to completion of a preceding software GUI test instance by the particular distributed test execution computer;

retrieve a software GUI test instance from the test queue in response to the request from the particular distributed test execution computer;

communicate the retrieved software GUI test instance to the particular distributed test execution computer for execution against a particular client-server combination using a testing component supported by the particular distributed test execution computer, the testing component operable to perform automated software GUI testing and to produce test results for such testing for communication to the test server engine;

receive a test result for the software GUI test instance from the particular distributed test execution computer in response to execution of the software GUI test instance; and

store the received test result for reporting to one or more users.
(Emphasis Added).

Independent claims 17, 32, and 47 recite similar limitations. Parker or Anderson either individually or in combination, fail to disclose, teach or suggest each and every limitation of independent claims 17, 32, and 47.

For example, Parker fails to disclose a centralized test queue operable to store a plurality of software GUI test instances to be executed by a plurality of distributed test execution computers. Although Parker discloses a system for automated GUI interface testing including a test script, a test executive, and a test driver (Column 3, Line 67 through Column 4 Line 13), Parker does not disclose a test script, or even a test driver capable of storing a plurality of software GUI test instances to be executed by one or more distributed test execution computers. In fact Parker teaches away from the claimed invention because the test executive of Parker is located on a particular machine, whether the machine is the particular machine (Figure 4) or even another machine (Figure 15). Thus Parker cannot provide for a centralized test queue since there is no centralization associated with any of the particular machines disclosed in Parker.

The Applicant further submits that the Office Action acknowledges, and Applicant agrees, that Parker fails to disclose the emphasized limitations of independent claims 1, 17, 32, and 47. Specifically, the Examiner acknowledges that Parker fails to disclose a “test queue” and “each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed”. (19 May 2005 Office Action, Pages 6-7).

However, the Examiner asserts that the cited portions of Anderson disclose the acknowledged shortcomings in Parker. The Applicants respectfully traverses the Examiners assertions regarding the subject matter disclosed in Anderson.

The Applicant respectfully submits that Anderson has nothing to do with independent claim 1, 17, 32, or 47 limitations regarding each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed. Rather Anderson discloses a temporary slaving and configuring of hardware resources (targets) to operate independently (Abstract), Anderson does not disclose, teach, or suggest that the temporary independent operation of these targets is automated. Although Anderson discloses that human intervention may be only required at a minimal degree and that a human operator can access the controller for information on the system status, results, and the like at any time, (Column 3, Lines 47-50), Anderson does not disclose that the minimal degree of human intervention is in any way associated with a client server combination that may be automatically tested using a centralized test queue. Thus Anderson cannot provide a centralized test queue operable to store a plurality of software GUI test instances to be executed by a plurality of distributed test execution computers, wherein each distributed test execution computer comprises a client platform and is coupled to one or more server platforms, collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed.

The Applicant further submits that the Office Action acknowledges, and Applicant agrees, that Parker or Anderson, either individually or in combination, fail to disclose the emphasized limitations of independent claims 1, 17, 32, and 47. Specifically, the Examiner acknowledges that Parker and Anderson fail to disclose: (1) the testing component is a commercial off-the shelf product; (2) generating a test results web page; (3) communicate the test results web page for display on a user system to provide substantially real-time test results reporting; and (4) test selections via a results web page. (19 May 2005 Office Action, Pages 14-19). However, the Examiner asserts that the cited portions of Estep disclose the acknowledged shortcomings in Parker and

Anderson. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in Estep.

The Applicant respectfully submits that Estep has nothing to do with independent claim 1, 17, 32, or 47 limitations regarding each distributed test execution computer comprising a client platform and coupled to one or more server platforms, the client platforms and server platforms collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed. Rather Estep discloses a process for testing commercial, off-the-shelf software products to determine functionality for specific criteria and presenting decision-making information in an interactive web-based repository. (Column 1, Lines 13-17). Estep merely includes information but fails to disclose, teach, or suggest that each distributed test execution computer comprises a client platform and is coupled to one or more server platforms, collectively providing a plurality of client-server combinations against which the software GUI test instances may be executed.

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Parker, Anderson, or Estep, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to include information regarding various network platform combinations in a GUI software test environment, including a test queue, as that allows for more fully testing of the software.

The Applicant further submits that these purported advantages relied on by the Examiner of allowing for a more fully testing of the software are nowhere disclosed, taught, or suggested in Parker, Anderson, or Estep either individually or in combination. The Applicant respectfully requests the examiner to point to the portions of Parker, Anderson, or Estep which contain the teaching, suggestion, or motivation to combine these references for the purpose of allowing for a more fully testing of the software. A recent

Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Parker, Anderson, or Estep either individually or in combination.

With respect to dependent claims 2-16, 18-31, and 33-46, claims 2-16 depend from independent claim 1, claims 18-31 depend from independent claim 17, and claims 33-46 depend from independent claim 32. As mentioned above, each of independent claims 1, 17, 32, and 47 are considered patentably distinguishable over Parker. Thus, dependent claims 2-16, 18-31, and 33-46 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicant submits that claims 2-16, 18-31, and 33-46 are not rendered obvious by the proposed combination of Parker, Anderson, and Estep. The Applicant further submits that claims 1-47 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-47 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-47 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20

U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

6/27/05
Date


James E. Walton, Registration No. 47,245
Brian E. Harris, Registration No. 48,383
Steven J. Laureanti, Registration No. 50,274
Daren C. Davis, Registration No. 38,425
Michael Alford, Registration No. 48,707
Law Offices of James E. Walton, P.L.L.C.
1169 N. Burleson Blvd., Suite 107-328
Burleson, Texas 76028
(817) 447-9955 (voice)
(817) 447-9954 (facsimile)
jim@waltonpllc.com (e-mail)

CUSTOMER NO. 53184
ATTORNEYS AND AGENTS FOR APPLICANT